



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,453	10/02/2001	Shulamit Eyal	20174C-002410US	9637

20350 7590 08/29/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER
----------

COOK, LISA V

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/970,453

**Applicant(s)**

EYAL ET AL.

**Examiner**

Lisa V. Cook

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/19/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicants' response to the Non-Final Office Action mailed September 29, 2005 is acknowledged (paper filed 1/27/06).
2. Currently, claims 1, 3-4, 7, and 10-13 are pending and under consideration. Claims 2, 5-6, 8-9 and 14-18 have been canceled at Applicants request.
3. Objections and/or rejections of record not reiterated below have been withdrawn.

### OBJECTIONS WITHDRAWN

#### *Information Disclosure Statement*

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 or Applicant on PTO-1449 has cited the references they have not been considered.
5. The information disclosure statement filed 1/31/02 has been considered as to the merits prior to first action.
6. The supplemental information disclosure statement filed 6/18/04 has been considered as to the merits prior to final action.
7. The supplemental information disclosure statement filed 9/19/05 has been considered as to the merits prior to final action.

*Applicant has submitted a supplemental IDS. Accordingly the objection is withdrawn.*

## NEW GROUNDS OF REJECTIONS

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

I. Claims 1, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopf-Sill et al. (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Crabtree et al. (Analytical Chemistry, 1999, 71, 2130-2138).

Kopf-Sill et al. disclose methods and microfluidic devices to measure reactants and reaction products while considering velocity. See column 1 line 64 through column 2 line 23.

Reactants and products with different velocities (characteristics of an analyte) are measured in a microfluidic channel. See column 2 lines 36-37 and lines 57-58. In one embodiment the fluid samples are transported from a first position to a second position by electroosmotic flow (claim 4). See column 6 lines 15-18. The time dependent data generated is processed to include baseline subtraction and masking for accurate measurements of the analyte of interest (normalizing and considering velocity). See column 1 lines 64-67 and column 22 lines 18-42.

Multiple detection positions/zones are taught at two different time points in figure 1. See figure 1 - Time= $t_2$  and Time= $t_4$  (time difference measurement). The time difference and velocity are utilized in an equation to accurately measure the characteristic of interest in the analyte (claims 8 and 9). See column 5 line 11 through column 6 line 43. The various reactants and products can be assessed serially (individually) or simultaneously in the methods (claim 5). See column 2 lines 34-35. Kopf-Sill et al. teach the step of normalizing or eliminating the velocity component in reaction measurements. See column 5 lines 55-62 and column 8 lines 10-22.

Kopf-Sill et al. and Kopf-Sill et al. differ from the instant invention in not teaching sample detection at a plurality of detection zones between a first position (sample entry time) and a second position (sample end time).

However, Crabtree disclose a particle detection method, which converts multiple-point (Shah function) time dependent measurements into fluorescence frequencies allowing for the viewing of analyte speed (analyte velocity). See abstract.

The SCOF (Shah convolution Fourier transform detection) principal is utilized in a system comprising multiple detection slits that detect the sample fluorescence at varied times ( $t=0$  through  $t=t_4$ ) during the flow of sample through a column or channel. For example, See figure 1 and page 2131. The particle is constantly interrogated (measured) at a number of evenly spaced points (slits or zones) along the column or channel simultaneously by a single detector and the signals measured from all of these points along the column are summed. See page 2131, 1<sup>st</sup> column, 3<sup>rd</sup> paragraph. This procedure advantageously isolated the analyte peak from interferences such as baseline drift and line noise. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use dual detection zones, slits, spaced zones (plurality of different detection zones) as taught by Crabtree et al. in either method of Kopf-Sill et al. (6,613,512 or 6,524,790) because Crabtree et al. taught that dual detection zones, slits, spaced zones advantageously isolated the analyte peak from interferences such as baseline drift and line noise. See abstract.

One of ordinary skill in the art would have been motivated to utilize dual detection zones (plurality of different detection zones) in order to more accurately detect the particles of interest.

II. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kopf-Sill et al. (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Crabtree et al. (Analytical Chemistry, 1999, 71, 2130-2138) as applied to claims 1, 3, and 4 above, and further in view of Squire et al. (Journal of Microscopy, 197(2) 2/2000, 136-149).

Please see Kopf-Sill et al. (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Crabtree et al. as set forth above.

Art Unit: 1641

Kopf-Sill et al. (US Patent #6,613,512) or Kopf et al.-Sill (US Patent #6,524,790) in view of Crabtree et al. differ from the instant invention in failing to teach acousto-optic modulators.

However, Squire et al. teach methods for measuring fluorescence with wave acoustic-optic modulators placed in a series. This configuration analyzed multiple data sets simultaneously and distinctly. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use acoustic-optic modulators as taught by Squire et al. in either method of Kopf-Sill et al. (6,613,512 or 6,524,790) in view of Crabtree et al. because Squire et al. taught that “standing wave acoustic-optic modulators provide a means of modulating a continuous wave laser in a sinusoidal manner at high frequencies.

A number of these [lasers] can be employed in series to simultaneously modulate the excitation light of individual frequencies, their differences, and sums.” See page 139 figure 2 and 2<sup>nd</sup> column last paragraph.

One of ordinary skill in the art would have been motivated to utilize these lasers in order to detect multiple frequencies simultaneously. Therein evaluating several analytes.

**III.** Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopf-Sill et al. (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Crabtree et al. (Analytical Chemistry, 1999, 71, 2130-2138) as applied to claims 1, 3, and 4 above, and further in view of Armstrong et al. (Cytometry, 40:102-108, 2/2000).

Please see Kopf-Sill et al. (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Crabtree et al. as set forth above.

Art Unit: 1641

Kopf-Sill et al. (US Patent #6,613,512) or Kopf et al.-Sill (US Patent #6,524,790) in view of Crabtree et al. differ from the instant invention in failing to teach oligonucleotide detection including nucleotide measurements.

However, Armstrong et al. teach this limitation. Their methods evaluate PCR probes that are linked to fluorescent molecules and measured by flow cytometry. See abstract. The method detects individual nucleotides from individual nucleotide fluorescence peaks. See figures 2, 3, and 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use detect oligonucleotides and the nucleotides which make up the oligonucleotides as taught by Armstrong et al. in either method of Kopf-Sill et al. (6,613,512 or 6,524,790) in view of Crabtree et al. because Armstrong et al. taught that genetic diversity is exhibited in disease and drug response and they can be effected by a single nucleotide difference/change/variant. See abstract.

### ***Response to Arguments***

9. Applicant contends that the combination of Kopf-Sill (US Patent #6,613,512) or Kopf-Sill et al. (US Patent #6,524,790) in view of Kosaka does not teach or suggest the instant invention because there was no suggestion or motivation to combine Kosaka with Kopf-Sill. Specifically, applicant argues that Kosaka was concerned with image resolution while Kopf-Sill involved reaction rates and concentration via fluorescence studies. This argument was carefully considered and found persuasive. Accordingly, the reference of Kosaka was removed from the rejection and replaced with Crabtree et al.



Crabtree et al. disclose the use of multiple measurements along the column of sample flow. The fluorescence measurements are combined and employed to measure the analyte and its mobility. See page 2131, 1<sup>st</sup> column, 3<sup>rd</sup> paragraph. This procedure advantageously isolated the analyte peak from interferences such as baseline drift and line noise. See abstract.

With respect to the rejections under 35 USC 103(a), including Squire et al. (Journal of Microscopy, 197(2) 2/2000, 136-149) and Armstrong et al. (Cytometry, 40:102-108, 2/2000), applicant contends that the additional references do not cure the deficiencies of Kopf-Sill or Kopf-Sill et al. in view of Kosaka. The rejection over Kopf-Sill or Kopf-Sill et al. in view of Kosaka has been addressed above. Kosaka has been replaced with Crabtree et al. Therefore the rejections are maintained.

10. For reasons aforementioned, no claims are allowed.

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 – Central Fax number is (571) 273-8300, which is able to receive transmissions 24 hours/day, 7 days/week. In the event Applicant would like to fax an unofficial communication, the Examiner should be contacted for the appropriate Right Fax number.

Art Unit: 1641

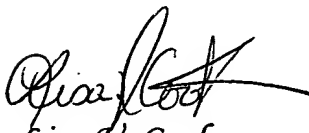
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (571) 272-0816. The examiner can normally be reached on Monday - Friday from 7:00 AM - 4:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (571) 272-0823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lisa V. Cook  
Patent Examiner  
Art Unit: 1641  
Remsen 3C-59  
(571) 272-0816

  
LONG V. LE 07/19/06  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600